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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,744	01/26/2001	Richard William Falla Le Page	031855.0092	7580

26118 7590 12/04/2002

BROBECK, PHLEGER & HARRISON, LLP
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1333 H STREET, N.W. SUITE 800
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EXAMINER

DEVI, SARVAMANGALA J N

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 12/04/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,744

Applicant(s)

Le Page et al.

Examiner

S. Devi, Ph.D.

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 26, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Election/Restriction

- 1) Claims 1-20 are under prosecution.
- 2) **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.
- 3) Restriction to one of the following inventions is required under 35 U.S.C. 121:
 1. Claims 1, 6 and 10, drawn to a *Streptococcus pneumoniae* protein or polypeptide shown in Table 1 or a fragment thereof, classified in class 530, subclass 350.
 2. Claims 2, 6 and 10, drawn to a *Streptococcus pneumoniae* protein or polypeptide of Table 2 or a fragment thereof, classified in class 530, subclass 350.
 3. Claims 6 and 10, drawn to a fragment of a *Streptococcus pneumoniae* protein or polypeptide of Table 3, classified in class 530, subclass 300.
 4. Claims 7 and 13, drawn to a DNA sequence set out in Table 1, classified in class 536, subclass 23.7.
 5. Claims 8 and 13, drawn to a DNA sequence set out in Table 2, classified in class 536, subclass 23.7.
 6. Claim 13, drawn to a nucleic acid sequence defined in Table 3, classified in class 536, subclass 23.7.
 7. Claim 15, drawn to an antibody capable of binding to a protein or polypeptide as defined in Table 1, classified in class 530, subclass 387.9.
 8. Claim 15, drawn to an antibody capable of binding to a protein or polypeptide as defined in Table 2, classified in class 530, subclass 387.9.
 9. Claim 15, drawn to an antibody capable of binding to a protein or polypeptide as defined in Table 3, classified in class 530, subclass 387.9.

10. Claim 9, drawn to a method of use of a protein or polypeptide of *Streptococcus pneumoniae* shown in Table 1, classified in class 436, subclass 543.
11. Claim 9, drawn to a method of use of a protein or polypeptide of *Streptococcus pneumoniae* shown in Table 2, classified in class 436, subclass 543.
12. Claim 9, drawn to a method of use of a protein or polypeptide of *Streptococcus pneumoniae* shown in Table 3, classified in class 436, subclass 543.
13. Claim 14, drawn to a method of detection of *S. pneumoniae* using a protein or polypeptide as defined in Table 1, classified in class 435, subclass 7.2.
14. Claim 14, drawn to a method of detection of *S. pneumoniae* using a protein or polypeptide as defined in Table 2, classified in class 435, subclass 7.2.
15. Claim 14, drawn to a method of detection of *S. pneumoniae* using a protein or polypeptide as defined in Table 3, classified in class 435, subclass 7.2.
16. Claim 17, drawn to a method of detection of *S. pneumoniae* using an antibody to a protein or polypeptide as defined in Table 1, classified in class 435, subclass 7.1.
17. Claim 17, drawn to a method of detection of *S. pneumoniae* using an antibody to a protein or polypeptide as defined in Table 2, classified in class 435, subclass 7.1.
18. Claim 17, drawn to a method of detection of *S. pneumoniae* using an antibody to a protein or polypeptide as defined in Table 3, classified in class 435, subclass 7.1.
19. Claim 18, drawn to a method of detection of *S. pneumoniae* using a nucleic acid as defined in Table 1, classified in class 435, subclass 6.
20. Claim 18, drawn to a method of detection of *S. pneumoniae* using a nucleic acid as defined in Table 2, classified in class 435, subclass 6.
21. Claim 19, drawn to a method of inactivating a protein or polypeptide shown in Table 1, classified in class 530, subclass 427.
22. Claim 19, drawn to a method of inactivating a protein or polypeptide shown in Table 2, classified in class 530, subclass 427.
23. Claim 19, drawn to a method of inactivating a protein or polypeptide shown in Table 3, classified in class 530, subclass 427.
24. Claim 20, drawn to a method of use of an agent capable of antagonizing the

function of a protein or polypeptide shown in Table 1, classified in class 435, subclass 961.

25. Claim 20, drawn to a method of use of an agent capable of antagonizing the function of a a protein or polypeptide shown in Table 2, classified in class 435, subclass 961.
26. Claim 20, drawn to a method of use of an agent capable of antagonizing the function of a a protein or polypeptide shown in Table 3, classified in class 435, subclass 961.

Claims 3-5 are considered as linking claims and would be joined with one of inventions 1 and 2, if elected.

Claims 11 and 12 are considered as linking claims and would be joined with one of inventions 1, 2 and 3, if elected.

Claim 16 is considered a linking claim and would be joined with one of inventions 7, 8 and 9, if elected.

4) Inventions 1-26 are patentably distinct from one another. Inventions 1-9 are drawn to different products which are structurally, biologically and/or immunogenically distinct from one another. Although some inventions are classified under the same class/subclass, the claimed sequences or products require separate structural searches that are non-coextensive. The products of inventions 1, 2 and 3 are not required to practice the methods of inventions 16 through 20. Similarly, the products of inventions 5 through 9 are not required to practice the methods of inventions 10 through 15 and 21 through 26.

5) After electing one of the above-identified inventions, Applicants should further elect one of the recited sequences or an antibody that is specific to one of the recited sequences for examination. a myriad of peptide substitution or deletion combinations are encompassed within each claim. The various claimed peptides having amino acid substitutions or deletions as recited at different positions differ from one another structurally, requiring separate, non-coextensive searches.

6) Inventions 1, 2 and 3 respectively, and inventions 10-12, inventions 13-15, inventions 21-23 and inventions 24-26, are related as product and process of using the product. The inventions

can be shown to be distinct if either or both of the following can be shown: (1) the process of using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P 806.05(h)). In the instant case, the protein or polypeptide of inventions I, 2 and 3 can be used in a materially different process, for example, as a product in the manufacture of a conjugate antigen by conjugating to a carrier protein.

7) Inventions 7, 8 and 9 and inventions 16, 17 and 18 respectively, are related as product and process of using the product. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process of using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P 806.05(h)). In the instant case, the antibody of inventions 7, 8 and 9 can be used in a materially different process, for example, as an immunogen to produce anti-idiotypic antibodies.

8) Inventions 4, 5 and 6 and inventions 19 and 20 respectively, are related as product and process of using the product. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process of using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P 806.05(h)). In the instant case, the nucleic acid of inventions 4, 5 and 6 can be used in a materially different process, for example, in the manufacture of a probe reagent for use in a diagnostic kit.

Because these inventions are distinct for the reasons given and have acquired a separate status in the art as shown by their different classifications/subclassifications and divergent subject matter, and since a search performed for one product would not be co-extensive to the other, restriction for examination purposes as indicated is proper.

9) Applicants are advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R 1.143).

10) Applicants are reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filled petition under C.F.R 1.48(b) and by the fee required under 37 C.F.R 1.17(h).

11) Any inquiry concerning this communication or earlier communications from the Examiner should be directed to S. Devi, Ph.D., whose telephone number is (703) 308-9347. a message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday to Friday from 7.15 a.m. to 4.15 p.m. except one day each bi-week which would be disclosed on the Examiner's voice mail system.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

November, 2002


S. DEVI, PH.D.
PRIMARY EXAMINER



RESTRICTION ELECTION FACSIMILE TRANSMISSION

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